



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Patent Application of)
Williams)
Serial No. 10/051,488) Hadi Shakeri
Filed: January 18, 2002) Examiner
For: **Multipurpose Foldable Candle Tool**) Group: 3723
Attorney Docket No. 4818-002)

Raleigh, North Carolina
March 1, 2004

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The present appeal brief is filed in triplicate pursuant to 37 C.F.R. § 1.192. Applicant also encloses a check number 11320 in the amount of \$165.00 as required by 37 C.F.R. § 1.17(c). Also enclosed is a check for \$210.00 along with an accompanying petition seeking a two-month extension of time to file this brief. Applicant is a small entity. If additional fees are required, the Commissioner is authorized to charge Deposit Account 18-1167.

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APPEAL BRIEF

(1) REAL PARTY IN INTEREST

The real party in interest is Scott G. Williams, whose address is 200 East Railroad Street, Pottsville, PA 17901.

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(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences to the best of Applicant's knowledge.

(3) STATUS OF CLAIMS

Claims 1, 2, 4-16 and 18-24 are pending in this application. All claims stand rejected except claims 13 and 14, which were indicated to be in condition for allowance in the Examiner's Interview Summary mailed August 26, 2003. Accordingly, Applicant appeals the rejection of claims 1, 2, 4-12, 15-16 and 18-24.

(4) STATUS OF AMENDMENTS

All amendments were made before the final office action was entered.

(5) SUMMARY OF INVENTION

The present invention is a candle tool 10. (Fig. 1). The candle tool is foldable and comprises a foldable handle structure 12 and 14. (Spec. p. 3). Joining the two handles together is a wick cutter 30. Wick cutter 30 includes a pair of jaws 32. The candle tool 10 includes a plurality of candle tools. These tools are pivotally connected to the handles 12 and 14. (Id.). One of the candle tools is a match holder 50. A wick dipper is also provided and indicated by the numeral 56. (Spec. p.4). There is also provided a candle scoop 64. Another candle tool secured to the handle 14 is a candle digger 17. (Spec. p. 4).

Figures 3A-3C show various other candle tools that can be incorporated into the candle tool 10. In Figure 3C there is shown a pre-fueled lighter 80. (Spec. p. 4). In Figure 3B there is

shown a wick lighter 82. Wick lighter 82 includes a sleeve 86. A wick 92 is contained within the sleeve and can be extended and retracted with respect to the sleeve. In Figure 3A the candle tool is shown to include a swab tool that is indicated by the numeral 100.

(6) ISSUES

Whether claims 1, 2, 4-7, 10, 15-16 and 20-23 are anticipated under 35 USC 102(b) over U.S. Patent No. 4,238,862, the Leatherman patent.

Whether claims 8 and 19 are unpatentable as being obvious in view of Leatherman and Gross, U.S. Patent No. 1,047,795.

Whether claims 9 and 18 are unpatentable as being obvious in view of Leatherman and Brown, Jr., U.S. Patent No. 5,553,340.

Whether claims 11, 12 and 24 are unpatentable as being obvious over Leatherman in view of Alexander, U.S. Patent No. 2,496,840.

(7) GROUPING OF CLAIMS

Group I: Claims 1, 2, 4-7, 10, 21, 22

Group II: Claims 15, 16, 20

Group III: Claim 23

Group IV: Claims 8 and 9

Group V: Claims 9 and 19

Group VI: Claims 11, 12 and 24

(8) ARGUMENT

A. The Law of Anticipation

Under 35 U.S.C. § 102, every element or limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim. *In re Bond*, 910 F.2d 831, 323 (Fed. Cir. 1990). Further, anticipation requires that the single prior art reference disclose every element of the claimed invention arranged in the same manner as claimed. *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In determining if a claim is anticipated, it is fundamental that the claim first be correctly construed. That is, the scope and meaning of each contested limitation must be determined. *Gechter* at 1457; *In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994). Thereafter, corresponding elements of the allegedly anticipating reference are identified. *Lindemann* at 1458. In the end, there can be no anticipation unless each and every element and limitation of the claimed invention, as properly construed, is found in the single prior art reference.

B. The Law of Obviousness

It is fundamental that rejections under 35 U.S.C. § 103 must be based on evidence comprehended by the language of that section. *In re Grasselli*, 713 F.2d 731, 739 (Fed. Cir. 1983). The basic and essential factual evidence on the issue of obviousness is set forth in *Graham v. John Deere, Co.*, 383 U.S. 1, 17-18 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation or suggestion to select and combine the references relied upon. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001) (the

central question is whether there is reason to combine the references, a question of fact drawing on the Graham factors.)

The mere fact that prior art can be modified to form a claimed invention does not make that modification obvious absent a showing that the prior art suggested the desirability of the modification. *In re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989); *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984).

A rejection based on § 103 must rest on a sound factual basis, and these facts must be arrived at without reconstructing the invention from the prior art through hindsight. In making this evaluation, all facts must be considered. The PTO has the initial duty and obligation of setting forth the factual basis for its obviousness rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply the deficiencies in its factual basis; *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967), cert. denied. 389 U.S. 1057 (1968).

The need for specificity pervades judicial decisions on the issue of obviousness. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”); *In re Rouffet*, 149 F.3d 1350, 1359, (Fed. Cir. 1998) (even when the level of skill in the art is high, the PTO must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the PTO must explain the reasons one of ordinary skill in the art would have been motivated to select the references and combine them to render the claimed invention obvious.”); *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992) (the Examiner can satisfy the burden of showing obviousness of the combination “only by showing some objective teaching in the prior art or that

knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”).

In supporting a position on obviousness, the PTO must set forth clear and particular findings and these findings must be competent. That is, with respect to core factual findings in determining patentability, the PTO cannot simply reach conclusions based on understanding or experience or on its assessment of what would be basic knowledge or common sense; *In re Zurko*, 258 F.3d 1379, 1385 (Fed. Cir. 2001). Rather, the PTO must point to some concrete evidence in the record in support of findings on obviousness. Id.

C. Leatherman Does Not Anticipate Claims 1, 2, 4-7, 10, 21, 22.

Claim 1 is as follows:

A foldable candle tool having a plurality of candle tools incorporated therein, comprising: a foldable handle structure moveable between a folded and closed position and an open and operative position; a series of candle tools mounted to the foldable handle structure with each tool being moveable from a storage position contained within the handle to an open operative position where the respective tools project outside of the handle structure; and wherein the candle tools include at least two candle tools taken from the group including a wick cutter, wick dipper, match holder, candle digger, lighter, swab, and a retractable wick.

In the initial office action the Examiner found and concluded as follows:

Claims 1-7, 10, 15-17 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Leatherman, US Patent No. 4,238,862.

Leatherman discloses all the limitations of claim 1 and 15, i.e., a foldable tool, having a plurality of tools comprising a foldable handle movable between a folded position and an open position, a series of tools mounted to the foldable handle structure with each tool being movable from a storage position within the handle to an operative position projected outside the handle. Handles having channel, a

wick cutter, i.e., pliers (22) with jaws (23) pivotally connected about a pivot pin (28) with legs connected to the handles.

Regarding the narrative and/or functional language, e.g., “candle” tool, lacking any structural limitations to define the tool, prior art, e.g., Leatherman is considered to meet the language.

The Examiner bases the anticipation finding on the conclusion that the Leatherman tool includes a foldable handle having a plurality of tools and comprising a foldable handle movable between a folded position and an open position. The Examiner concluded that the terms “candle tool” and “candle tools” were met by the Leatherman patent. The Examiner also concluded that the Leatherman patent fully met the limitation of

at least two candle tools taken from the group including a wick cutter, wick dipper, match holder, candle digger, lighter, swab and a retractable wick.

See claim 1. With respect to claim 15 the Examiner concluded that the Leatherman patent fully met a candle tool having

at least two tools taken from the group including a wick dipper, match holder, candle scoop, candle digger, pre-fuel lighter, wick lighter and an extendable swab.

See claim 15. Of particular note is that the Examiner only discussed one candle tool, i.e., the wick cutter, and applied the pliers 22 of Leatherman to meet this claim term. Apparently the Examiner overlooked that both claims 1 and 15 require at least two specific candle tools from each of the recited groups.

1. The Examiner Has Not Made Out a Prima Facie Case of Anticipation

The burden is on the Examiner to make out a prima facie case of anticipation. See *In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986). For at least two reasons, the Examiner has failed to make out a prima facie case that claim 1 and claim 15 are anticipated.

First the Examiner must show that each and every element of the claim is met by Leatherman. Apparently the Examiner believes that claims 1 and 15 only require one candle tool from the recited group. However, clearly that is not the case. In both claims 1 and 15, the claims particularly require at least two candle tools taken from the recited group. The Examiner has pointed to what he considers to be one candle tool, that is the pliers 22 of Leatherman. But that alone, even if correct, is insufficient to establish a *prima facie* case of anticipation. It was incumbent upon the Examiner to specifically point to the second candle tool found in the Leatherman patent. The Examiner did not and under those circumstances no *prima facie* case of anticipation has been made out. For this reason, and this reason alone, the Examiner's §102 rejection must be reversed.

Secondly, the Examiner concluded that the terms "candle tool," "wick dipper," "match holder," "candle digger," "candle scoop," "pre-fuel lighter," "extendable swab," etc. lacked "any structural limitations to define the tool, prior art, e.g., Leatherman is considered to meet the language." That conclusion is error. The structural components of Mr. Williams' candle tool have been defined by terms such as "wick cutter," "wick dipper," "candle digger," "wick lighter," "extendable swab," etc.

Apparently it is the Examiner's position that these terms can be dissected and any portions of the terms that have functional connotations can be ignored for purposes of Section 102. Mr. Williams is unaware of any authority that permits the Patent Office to dissect names or terms given structural elements and ignore portions that have functional connotations. That is what is at issue in this case. The Examiner has neither discussed the dissection of terms intended to define structure, nor has the Examiner come forward with any authority endorsing such a Section 102 analysis.

2. The Examiner's Explicit Holding That Applicant Cannot Utilize a §1.132 Declaration to Rebut a Prima Facie Case of Anticipation is Wrong As A Matter of Law

As noted above, the Examiner did not make out a prima facie case of anticipation.

Nevertheless, Mr. Williams submitted a Rule 132 Declaration rebutting the 102 rejection. (See Ex. 1, Williams Decl.) The substance of the Williams' Declaration will be discussed subsequently herein.

The Examiner refused to even consider Mr. Williams' 132 Declaration for purposes of the 102 rejection. The Examiner was quite clear:

The declaration under 37 CFR 1.132 filed 06/06/03 is insufficient to overcome the rejection of claims 1-7, 10, 15-17 and 20 since an affidavit/declaration submitted under 37 CFR 1.132 for the purpose of traversing grounds of rejection does not apply to rejections under 35 USC 102(b), anticipation, as is the case here,¹

This is clear error. Section 132 affidavits or declarations are just as applicable for Section 102 rejections as they are for Section 103 rejections. Section 1.132 is as follows:

Affidavit or Declaration Traversing Grounds of Rejections or Objections

When any claim of an application or patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this action.

37 CFR 1.132. This provision of the CFR is unambiguous. A rejection is a rejection whether it is under Section 102 or Section 103 and it is perfectly appropriate for an applicant to traverse a 102 rejection with a Section 1.132 declaration.

¹ The Examiner did, however, state, but only in conclusory fashion, that Mr. Williams' Section 132 Declaration would be considered for the §103 rejections.

There can be no question that this is error on the part of the Patent Office. Mr. Williams' Declaration must be considered. It was clear error, as a matter of law, to take the position that a Section 1.132 declaration was not appropriate for a Section 102 rejection. For this reason alone, the 102 rejection by the Examiner must be reversed.

3. Mr. Williams' Declaration Rebutts the Examiner's Anticipation Argument.

Anticipation is a question of fact. *In re Bond* at 833. In order to affirm the Examiner's decision, there must be substantial evidence in the record to support the Examiner's finding. *In re Height*, 211 F.3d 1367 (Fed. Cir. 2000). It is difficult to see where the Examiner made any factual findings that provide substantial evidentiary support for his anticipation rejection. What is very clear, as alluded to above, is that the Examiner refused to consider the testimony of Mr. Williams regarding anticipation.

Mr. Williams testifies that the terms "wick cutter," "wick dipper," "candle digger," "candle scoop," "retractable wick," etc. are all technical terms that are recognized and understood by those skilled in the art. Williams Decl. ¶ 3. That evidence is uncontested. Mr. Williams further testified that these terms describe the structure of the particular tool being referred to. He goes on to state that when these terms are used in the patent application they are not simply terms that describe a function of a device, but that they describe the structure of the particular tool. Id. All of this testimony stands unrebutted. Indeed since the Examiner refused to even consider Mr. Williams' testimony, the Examiner did not even review the testimony to determine its probative value. Again, as discussed above, the testimony was intentionally and expressly ignored.

Mr. Williams also speaks to the question of claim construction. Here Mr. Williams testifies that the candle tool terms "wick cutter," "wick dipper," "wick or candle digger," or

“retractable wick” cannot be construed or interpreted to mean any one of various types of tools incorporated into the Leatherman tool. William’s Decl. ¶ 5. Mr. Williams goes on to say that the respective candle tools of his invention and the Leatherman tools are different and that the technical terms of “wick cutter,” “wick dipper,” “candle or wick digger,” etc. all distinguish his invention from the Leatherman tool. Id. Again, this testimony stands uncontradicted and indeed the Examiner does not even offer an argument against such.

In paragraph 7 of his declaration, Mr. Williams notes that he has been buying and merchandising candles for over ten years and that his company has sold candles across the United States. He indicates that he has never seen or heard of a Leatherman tool or a Leatherman-like tool being used to work or operate on a candle. Williams Decl. ¶ 7. He also indicates that as a matter of fact, the Leatherman tool does not include a wick cutter, wick dipper, wick or candle digger, or a retractable wick as those terms are used in the patent application and as those terms are understood by those skilled in the art. Williams Decl. ¶¶ 3&4.

The Examiner’s 102 analysis fails to address the significance of the terms “wick cutter,” “wick dipper,” “match holder,” “candle digger,” “lighters,” “swab,” “retractable wick,” etc. Indeed, as discussed above, the Examiner summarily dismissed Mr. Williams’ testimony under §1.132 maintaining that such evidence was prohibited in a Section 102 context. That is, of course, wrong as a matter of law. In short, the Examiner never engaged in any claim construction analysis. *Gechter* at 1457. Further, the Examiner never considered the true significance of terms such as “wick dipper,” “candle digger,” etc. Without any discussion or analysis, the Examiner dissected these technical terms and based his anticipation analysis on only a part of these terms.

Anticipation is a question of fact and the burden is on the Examiner to make out a *prima facie* case of anticipation. The Examiner's conclusionary holding is unsupported. The Examiner never engaged in any fact-finding exercise. In short there is no substantial evidence to support the Examiner's conclusionary holding. That must be contrasted with the evidence put forth by Mr. Williams. Notwithstanding the burden of the Examiner, Mr. Williams' testimony is fact specific and not one single fact set forth in Mr. Williams' declaration is controverted by the Patent Office. The Examiner's 102 rejections must be reversed.

4. Mr. Williams Has Disclaimed Any Interpretation Of The Claims That Would Read On Leatherman.

There is a well-known maxim in patent law that relates fundamental principles of infringement with fundamental principles of anticipation. "That which infringes if later anticipates it earlier." *Polaroid Corp. v. Eastman Kodak Co.*, 789 F.2d 1556, 1573 (Fed. Cir. 1986). It is inconceivable that any court would find Mr. Williams' claims to his candle tool infringed by the Leatherman tool.

So that there is no misunderstanding, Mr. Williams has expressly disclaimed any interpretation of the candle tool terms that would cover any one of the tools or devices incorporated into the Leatherman patent. Williams Decl. ¶ 6. This disclaimer is now an important part of the prosecution history. Any interpretation of the claims must be consistent with both the specification and prosecution history. *In re Dance*, 160 F.3d 1339, 1344 (Fed. Cir. 1998) (noting that "[t]he Commission relies that the patent examiner is obligated to give Dance's claims the broadest reasonable interpretation in view of the specification and prosecution history....."). See also *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997) ("prosecution history is equally helpful in defining the interpretation sought by Appellants").

In this case Mr. Williams has expressly disclaimed any interpretation of his claims that would cover any one of the tool devices incorporated into the Leatherman patent. There is nothing vague or conclusionary about the disclaimer. Indeed the above statements taken from Mr. Williams' prosecution history without doubt give rise to classic prosecution history estoppel. Accordingly, the Examiner should not have construed the claims to be inconsistent with the prosecution history or to read on the Leatherman patent.

5. The Examiner Never Relyed on the Doctrine of Inherency and Mr. Williams Had No Obligation to Come Forward with Any Evidence

While Mr. Williams did come forward with a Section 1.132 declaration, the Examiner never relied on the doctrine of inherency. As noted above, in the first office action, the Examiner's position was very clear. He indicated: "Leatherman discloses all the limitations of claims 1 and 15, i.e., a foldable tool....." (See text of rejection, p. 6 herein).

Then at the end of that paragraph the Examiner concludes:

Regarding the narrative and/or functional language, e.g., "candle" tool lacking any structural limitations to define the tool, prior art, e.g., Leatherman is considered to meet the language.

There is absolutely no mention of the doctrine of inherency in the first office action.

The final rejection issued July 29, 2003 was identical or nearly identical to the 102 analysis that appeared in the first office action. Again, in the rejection of the claims under Section 102, the Examiner did not rely on the doctrine of inherency. But again concluded that Leatherman disclosed all the limitations of claims 1 and 15 and that Leatherman is considered to meet the language of the claims.

D. Claim 15 is Not Anticipated.

All of the arguments appearing above with respect to claims 1, 4-7, 10, 21 and 22 are equally applicable to claim 15. For all of these reasons, the rejection of claim 15 must be reversed.

Paragraph (f) of claim 15 provides:

f. wherein the plurality of candle tools includes at least two tools taken from the group including a wick dipper, match holder, candle scoop, candle digger, pre-fuel lighter, wick lighter, and an extendable swab.

In the rejection of claim 15 the Examiner does not discuss the limitations of paragraph f. Accordingly, the Examiner has failed to make out a *prima facie* case of anticipation.

It is acknowledged that some of the limitations set forth in paragraph f of claim 15 are discussed in the Examiner's rejection of claims 2-7, 10, 16, 17, and 20-22. Even here the Examiner concludes erroneously that a wick dipper is met by the screwdriver 73 of Leatherman, that the match holder is met by the pliers 35 of Leatherman, and that the candle digger is met by the file 76 or the fingernail grip 80 of Leatherman.

E. Claim 23 is Not Anticipated.

Claim 23 is as follows:

A foldable candle tool having a plurality of candle tools incorporated therein comprising: a foldable handle structure movable between a folded and closed position and an open and operative position; a series of candle tools mounted to the foldable handle structure with each candle tool being movable from a storage position contained within the handle to an open operative position where the respective candle tools project outside the handle structure; and wherein the candle tools include at least one candle tool taken from the group including an L-shaped wick dipper and a candle swab.

All of the arguments appearing above with respect to the Examiner's anticipation rejection are applicable here. For all of the reasons set forth above with respect to the rejection of these claims, the rejection of claim 23 should be reversed.

Additionally, claim 23 calls for the candle tools to include at least one tool taken from the group including an L-shaped wick dipper and a candle swab. Here the Examiner has focused on the L-shaped wick dipper. The Examiner maintains that this term is fully met by the screwdriver bit 79 of the Leatherman tool. The screwdriver bit is, of course, not a wick dipper as the Williams' declaration establishes. Notwithstanding, the screwdriver bit 79 in the Leatherman tool is not L-shaped. The extension that holds the screwdriver bit 79 does include a fingernail grip. But that does not make the structure L-shaped or an L-shaped wick dipper.

F. All of the Obviousness Rejections Should Be Reversed Because They Depend On Leatherman to Meet the Specific Candle Tool Limitations.

All of the obviousness rejections are based on the primary reference of Leatherman. As discussed in the anticipation analysis above, the Examiner maintains that each of the specific candle tools, that is the wick cutter, wick dipper, match holder, candle digger, etc. is fully met by the Leatherman reference. Further, as discussed above, the position of the Examiner is that these elements are expressly met. The Examiner in putting forth the Section 102 rejections does not take the position that the claims include functional limitations not expressly met by Leatherman, but that the Leatherman device would be inherently capable of performing the functions of the claimed invention.

If the doctrine of inherency was being relied on by the Patent Office, then that alone would require reversal of the obviousness rejections. This is because inherency is not applicable

to a Section 103 rejection. Inherency and obviousness are distinct concepts. See *In re Dillon*, 919 F.2d 688, 718 (Fed. Cir. 1990).

G. Claim 8 Is Not Obvious

Claim 8 is as follows:

The foldable candle tool of claim 7 further including a candle scoop for scooping wax and debris formed in and around a candle wick and a candle digger for digging into the wax of a candle in and around the wick.

Claim 8 stands rejected as being obvious in view of Leatherman and Gross. The Examiner acknowledges that Leatherman does not include a candle scoop. The patent to Gross does teach a device that includes a spoon 12. Given that the Examiner concludes:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tool of Leatherman with a foldable tool in form of a spoon as taught by Gross to adapt the combination tool to accommodate various utensils for use at the table.

The burden is on the Patent Office to establish a *prima facie* case of obviousness. It is fundamental that in order to do so the Examiner must establish that the primary reference after modification includes each and every element and limitation, whether structural or functional, in the claim. Secondly, the Examiner must show that there is a motivation that would have induced someone ordinarily skilled in the art to make the combination in the first place and to modify the primary reference in the second place. The Examiner has failed to make out a *prima facie* case of obviousness on both accounts.

As discussed earlier, the modified Leatherman tool does not expressly include the structural limitations that are articulated for the various candle tools recited in the claim. Secondly, the alleged motivation is unsupported, conclusionary and is based on classic hindsight. Nowhere in the prior art, or in the record for that matter, is there any evidence to suggest why a

person of ordinary skill in the art would want to make the Leatherman tool an eating utensil.

Indeed, the idea of eating with a tool that has connected thereto a pair of pliers and a screwdriver is not that appetizing. If for no other reason, a concern for the eating utensil to be sterile and maintained within a sanitary environment would have a tendency to dissuade anyone from placing a spoon on the Leatherman tool. Dirt, grease and other debris normally associated with a Leatherman-like tool would be a concern.

Further, it is important to appreciate that the Leatherman device is a pocket tool. It is not a utensil. The inventor of the Leatherman tool states:

Certain tools are often needed in situations where it is impractical or at least inconvenient to go prepared with a well-equipped toolbox. For example, hunters, fishermen, campers, bicyclists and even motorcyclists and automobilists have frequent need for a variety of common tools, which are not available when the need arises.

Leatherman, col. 1, lines 8-14. Then in the summary of the invention, the inventor stresses the tool and how the individual tools are secured to the pair of channel shaped handles. Again, the emphasis is on a “tools” such as a pair of pliers and a screwdriver - not on an eating utensil.

There is nothing of record that would suggest the desirability or need for adapting the Leatherman tool “for use at the table.” The rejection of claim 8 should be reversed.

H. Claims 9 and 18 Are Not Obvious

The Examiner has rejected claim 9 as being obvious in view of Leatherman and Brown, Jr. Here the Examiner relies on the foldable file 44 and the wire tool 30 of Brown. Even if there was a proper motivation in this case, a *prima facie* case of obviousness is not made out because the wire tool 30 does not assume an L-shape. It simply has a slight bend in it. Therefore, there is no *prima facie* case of obviousness here.

Secondly, the proffered motivation to combine is flawed. The Examiner states the following motivation:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tool of Leatherman with the file and wire tool as taught by Brown, Jr. to adapt the combination tool for cleaning spark plugs and for cleaning hard to reach crevices.

This motivation is unsupported. It is difficult to appreciate why the Examiner believes it would be obvious to create a spark plug cleaning device in the context of this obvious analysis. There is nothing in the record that would suggest the desirability to turn the Leatherman tool into a spark plug cleaning device. This motivation is inspired by hindsight and is conclusionary. Neither Applicant's invention nor the Leatherman tool has anything to do with cleaning spark plugs or cleaning crevices. Where the Examiner found this motivation is impossible to discern. Again, the Leatherman patent is not about cleaning, but is about having at hand a number of tools for carrying out work. The tools include pliers, screwdrivers, can openers, scissors and the like. There is not one single cleaning tool in the Leatherman device. In the final analysis, there is in reality no motivation to combine in this case. The fact that references can be combined does not make it obvious to combine them absent a showing that the prior art suggested the desirability of the modification. *In re Laskowski*, 187 F.2d 115, 177 (Fed. Cir. 1989); *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984).

I. Claim 11 is Not Obvious

Claim 11 stands rejected as being unpatentable over Leatherman in view of Alexander. Claim 11 is as follows: "The candle tool of claim 1 wherein one of the candle tools includes a pre-fuel lighter."

The Examiner acknowledges that Leatherman does not include a pre-fuel lighter but cites Alexander as teaching a pre-fuel lighter. The proffered motivation for combining Alexander with Leatherman is as follows:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tool of Leatherman with the lighter as taught by Alexander to adapt the combination tool for sportsmen carrying means for igniting a fire.

The articulated motivation is again conclusionary, unsupported, and in reality based on hindsight. It appears that it is the position of the Examiner that it would be obvious to modify the Leatherman tool to include any known tool, implement, utensil or accessory. In any event, Alexander relates to a sportsman's knife that includes a member 20 and a blade 21. When the surface of the member 20 is rubbed against the blunt edge of the blade 21, sparks are produced and the Alexander patent indicates that the sparks will ignite a wick and the flames may be used to ignite a fire.

The basis for the Examiner's proffered motivation is that it would simply be obvious to adapt the Leatherman tool to carry out one more function. Respectfully that is not how the requirement of motivation works. There must be something in the record from which the Patent Office can base the motivation on. Essentially the Examiner's position is that it would be obvious to modify the Leatherman tool with any or all tools and devices found in all of the combination tools of the prior art. That, of course, is not the case. Simply because Alexander can be combined with Leatherman, does not make the combination obvious. See *Laskowski* at 117. There must be something in the prior art to suggest the desirability for such. The suggestion cannot be based on Mr. Williams' disclosure and hindsight. There is no reason to

believe that a person of ordinary skill in the art would be motivated to turn the basic Leatherman tool into a fire-starting device.

J. Claims 12 and 24 Are Not Obvious

Claims 12 and 24 stand rejected as being obvious in view of Leatherman and Alexander.

Claim 12 is as follows:

The foldable candle tool of claim 1 wherein one of the candle tools includes a sleeve having an extendable and retractable wick incorporated therein where the wick functions to light a candle.

For the same reasons advanced above, the proffered motivation for combining Alexander and Leatherman is insufficient to establish a *prima facie* case of obviousness. Again, the motivation is conclusionary, unsupported and based on hindsight. Claim 12 calls for “an extendable and retractable wick.” There is no indication in Alexander that the wick therein is both extendable and retractable. The Examiner indicates that the wick is “expandable and retractable.”² The Examiner asserts that the wick can be pulled out or pushed in the sleeve. There is no evidence in Alexander that a thin ropelike wick can be pushed back into the sleeve.

The Patent Office has not made out a *prima facie* case of obviousness with respect to claims 12 and 24 and therefore the rejection should be reversed.

Conclusion

For the above stated reasons, claims 1, 2, 4-12, 15, 16, and 18-24 define patentable subject matter and certainly define over Leatherman, Brown, Gross, and Alexander. Accordingly, Applicant respectfully requests that the Board of Patent Appeals and Interferences reverse the Examiner and find that claims 1, 2, 4-12, 15, 16, and 18-24 are allowable.

² It is assumed that the Examiner means extendable and not expandable.

Respectfully submitted,

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(9) APPENDIX

Claims

1. A foldable candle tool having a plurality of candle tools incorporated therein, comprising: a foldable handle structure moveable between a folded and closed position and an open and operative position; a series of candle tools mounted to the foldable handle structure with each tool being moveable from a storage position contained within the handle to an open operative position where the respective tools project outside of the handle structure; and wherein the candle tools include at least two candle tools taken from the group including a wick cutter, wick dipper, match holder, candle digger, lighter, swab, and a retractable wick.
2. The foldable candle tool of claim 1 wherein the foldable handle structure includes a pair of handles that are adapted to be disposed in an extended position where the respective handles are disposed in general parallel relationship to each other.
3. Canceled
4. The foldable candle tool of claim 1 wherein the handle structure includes a pair of handles and a wick cutter, and wherein the wick cutter includes a pivot joint and a pair of legs with each leg being pivotally connected to one end of the respective handles.
5. The foldable candle tool of claim 4 wherein in the folded position the wick cutter is housed with both handles.

6. The foldable candle tool of claim 1 wherein the handle structure includes a pair of handles with each handle having an open channel formed on one side thereof; and wherein one or more of the series of candle tools are pivotally connected to one end of at least one handle such that in the stored position, the candle tools assume a position within the channel of one of the respective handles.
7. The foldable candle tool of claim 1 including a wick cutter, a wick dipper for engaging a candle wick and submerging the candle wick within melted wax to extinguish the candle wick, and a match holder for engaging and holding a match.
8. The foldable candle tool of claim 7 further including a candle scoop for scooping wax and debris formed in and around a candle wick and a candle digger for digging into the wax of a candle in and around the wick.
9. The foldable candle tool of claim 7 wherein the wick dipper includes an arm secured to one handle of the candle tool and a generally L-shaped wire secured to a terminal end of the arm and extending therefrom.
10. The foldable candle tool of claim 4 wherein the wick cutter includes a pair of jaws that are pivotally connected about a pivot pin and a pair of legs with each leg being pivotally connected to an end portion of the handle structure.

11. The foldable candle tool of claim 1 wherein one of the candle tools includes a pre-fueled lighter.

12. The foldable candle tool of claim 1 wherein one of the candle tools includes a sleeve having an extendable and retractable wick incorporated therein where the wick functions to light a candle.

13. The foldable candle tool of claim 1 wherein one of the candle tools includes a sleeve adapted to receive a swab and wherein the sleeve is provided with an actuator that is effective to extend and retract the swab from the sleeve.

14. The foldable candle tool of claim 13 wherein the swab is disposable.

15. A foldable candle tool having a series of tools for operating on a candle, comprising:

- a. a pair of handles with each handle having an open channel formed therein;
- b. a wick cutter having a pair of jaws pivotally connected about a pivot pin and including a pair of legs;
- c. each of the legs of the wick cutter being pivotally connected to one end of one handle such that the handles are effectively coupled together by the wick cutter;
- d. the handles being moveable between a closed position where the open channels of each handle face each other and the wick cutter is at least partially housed within opposed channels, and an open position where the wick cutter projects from the two handles;

- e. a plurality of candle tools moveably mounted to the handles with each candle tool moveable from a stored position within one channel to a position where the candle tool projects outwardly from the handle; and
- f. wherein the plurality of candle tools include at least two tools taken from the group including a wick dipper, match holder, candle scoop, candle digger, pre-fuel lighter, wick lighter, and an extendable swab.

16. The foldable candle tool of claim 15 wherein each of the plurality of candle tools are pivotally connected to respective handles.

17. Canceled

18. The foldable candle tool of claim 15 wherein the plurality of tools includes a wick dipper pivotally connected to one handle, the wick dipper including an arm and a generally L-shaped wire secured to the arm and extending therefrom.

19. The foldable candle tool of claim 15 wherein the plurality of candle tools includes a wick dipper, an alligator clip, and a candle scoop.

20. The foldable candle tool of claim 15 wherein the plurality of candle tools includes at least two candle tools pivotally connected to the end of one handle opposite the end where the wick cutter is connected, and at least two other candle tools pivotally connected to the end of the other handle opposite the end where the wick cutter is connected.

21. The foldable candle tool of claim 1 wherein the candle tool includes at least three candle tools taken from the group including a wick cutter, wick dipper, match holder, candle digger, lighter, swab, and a retractable wick.
22. The foldable candle tool of claim 1 wherein the candle tool includes at least four candle tools taken from the group including a wick cutter, wick dipper, match holder, candle digger, lighter, swab, and a retractable wick.
23. A foldable candle tool having a plurality of candle tools incorporated therein comprising: a foldable handle structure movable between a folded and closed position and an open and operative position; a series of candle tools mounted to the foldable handle structure with each candle tool being movable from a storage position contained within the handle to an open operative position where the respective candle tools project outside the handle structure; and wherein the candle tools include at least one candle tool taken from the group including an L-shaped wick dipper and a candle swab.
24. The foldable candle tool of claim 23 wherein the candle tools include a retractable wick.